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In re Application of:

ODDO, Anthony, Scott, et al. :
U.S. Application No.: 10/552,784 :
PCT No.: PCT/US2004/010311 :
International Filing Date: 02 April 2004 :
Priority Date: 03 April 2003 :
Attorney's Docket No.: SEDN/PRED115 :
For: CONTENT NOTIFICATION AND
DELIVERY :

DECISION ON PETITION UNDER
37 CFR 1.47(a)

This decision is issued in response to applicants' Petition Under 37 CFR 1.47(a), filed 09 June 2006. Deposit Account No. 20-0782 will be charged the required petition fee.

BACKGROUND

On 02 April 2004, applicants filed international application PCT/US2004/010311. The international application claimed a priority date of 03 April 2003, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 03 October 2005.

On 29 September 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 11 May 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date was required.

On 09 June 2006, applicants filed a response to the Notification Of Missing Requirements. The submission includes the required surcharge payment, declarations executed by two of the five inventors, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signatures of the three remaining inventors (Thomas L. RENGER, Devin F. HOSEA, and Nathaniel J. THURSTON), whom applicants assert have refused to execute the application or cannot be located after diligent effort.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have authorized a charge to Deposit Account No. 20-0782 for the required petition fee. Item (1) is therefore satisfied.

With regard to item (2), the petition lists three different addresses as the "last known address" for inventor Nathaniel THURSTON, two different addresses as the "last known address" for inventor Devin F. HOSEA, and one address for inventor Thomas J. RENGER. Based on the above, the petition satisfies item (2) with respect to Mr. RENGER. However, an express statement as to which of the multiple addresses listed is the last known home address for the other two non-signing inventors is required (see MPEP section 605.03). Based on the above, item (2) is not satisfied with respect to inventors THURSTON and HOSEA.

Regarding item (3), section 409.03(a) of the MPEP states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by the two cooperating inventors and containing unsigned signature blocks for the three non-signing inventors. This declaration may be accepted as having been executed by the signing inventors on their own behalf and on behalf of the non-signing inventors. Item (3) is therefore satisfied.

Regarding item (4), applicants state that the non-signing inventors refuse to execute the application or cannot be located after diligent effort. With respect to the inability to locate an inventor, MPEP section 409.03(d) states the following:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

In the alternative, where it is asserted that the inventor refuses to sign the application, MPEP section 409.03(d) states that “[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants have provided a declaration from Yvette Thornton, with supporting documents, providing a firsthand account of the efforts made to obtain the signatures of the three non-signing inventors.¹ These materials provide an adequate showing that inventor Thomas J. RENGER has been located, has been provided with a request for signature accompanied by a copy of the complete application, and that the inventor has failed to provide the requested signature (the inventor has requested payment for reviewing the application materials). These materials provide an acceptable showing that inventor Thomas J. RENGER has refused to execute the application.

The materials regarding the other two non-signing inventors, however, require further clarification. With respect to inventor Nathaniel J. THURSTON, Ms. Thornton states that internet searches were conducted to identify addresses and telephone numbers for this inventor; however, the specific results of such searches are not provided. In addition, the petition lists

¹ Applicants have also included materials regarding the inventor's obligations to assign the application. However, such materials are not relevant to the issue of whether the inventors have refused to execute the application or cannot be located after diligent effort.

three "last known addresses" for this inventor, without stating how such addresses were identified. Also, petitioner has not explained why documents were apparently only mailed to two of the three listed addresses (the petition includes copies of envelopes directed to Mr. THURSTON at two of the addresses, both of which were undeliverable). A firsthand statement of precisely what searches were conducted to locate this inventor, what was obtained from each such search, and the diligent efforts made by applicants to contact the inventor in light of the results of these searches is necessary before it can be concluded that this inventor cannot be located after diligent effort (available documentary support should also be provided, including copies of internet search results, etc.).

With respect to inventor Devin F. HOSEA, it appears from Ms. Thornton's statement and the attached materials states that at least one mailing directed to this inventor was signed for by the inventor (the 20 October 2005 certified mailing), and that a subsequent mailing to this address which included the complete application papers was refused. However, Ms. Thornton has not included copies of the letters included in these mailings, so it is not clear whether a refusal to execute the present application can be inferred in the present circumstances. A firsthand statement as to what was included in the mailing received by this inventor, and what was included in the subsequent mailing refused by the inventor, is required (with available documentary support, i.e., copies of the cover letters included, and a description of the enclosures) before it can be concluded that this inventor has refused to execute the application.²

Based on the above, item (4) is satisfied with respect to inventor RENGER; however, item (4) is not satisfied on the present record with respect to inventors THURSTON and HOSEA.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy items (2) and (4) of a grantable petition with respect to non-signing inventors THURSTON and HOSEA, as discussed above.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

² Ms. Thornton has included with her statement copies of emails addressed to Mr. HOSEA; however, applicants have not provided a firsthand statement regarding how this email address was identified and verified. Accordingly, it cannot be determined from the present record whether these emails should be treated as having been properly directed to this inventor.

Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents
of the letter marked to the attention of the Office of PCT Legal Administration.



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